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Dean M. Willard

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GIFFORD, KRASS, SPRINKLE, ANDERSON et. al.
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EXAMINER

HANDY, DWAYNE K

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08/06/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-4, 6, 9, 12 and 13 are rejected under 35 U.S.C. 102(e) as being anticipated by Mainwaring et al. (6,779,657). This rejection was applied in the previous Office Action (mailed 12/31/07). It remains in effect. Please see Response to Arguments below.

Inventorship

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claims 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mainwaring et al. (6,779,657) in view of Boeder (4,373,077). This rejection was applied in the previous Office Action (mailed 12/31/07). It remains in effect. Please see Response to Arguments below.

6. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mainwaring et al. (6,779,657) in view of Spinu et al. (5,210,108). This rejection was

applied in the previous Office Action (mailed 12/31/07). It remains in effect. Please see Response to Arguments below.

Response to Arguments

7. Applicant's arguments filed 5/21/08 have been fully considered but they are not persuasive.

8. The Examiner notes that the previous 112 rejection has been removed in response to Applicant's Arguments. Applicant has responded with a statement that the phrase in question is an attempt at a limitation using functional language. The Examiner does disagree, however, with Applicant's arguments that the phrase in question is a functional limitation. The Examiner submits that this phrase is not a functional limitation but instead an intended use.

9. The Examiner directs Applicant to the following portions of sections 2114 and 2115 from the MPEP on Functional Language and Intended Use. The Examiner has highlighted the most relevant MPEP portions.

2114 [R-1] Apparatus and Article Claims — Functional Language

APPARATUS CLAIMS MUST BE STRUCTUR-ALLY DISTINGUISHABLE FROM THE PRIOR ART

While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) (The

absence of a disclosure in a prior art reference relating to function did not defeat the Board's finding of anticipation of claimed apparatus because the limitations at issue were found to be inherent in the prior art reference); see also *In re Swinehart*, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971); < *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). "[A]pparatus claims cover what a device is, not what a device does." *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original).

MANNER OF OPERATING THE DEVICE DOES NOT DIFFERENTIATE APPARATUS CLAIM FROM THE PRIOR ART

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. Ex parte Masham, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987) (The preamble of claim 1 recited that the apparatus was "for mixing flowing developer material" and the body of the claim recited "means for mixing ..., said mixing means being stationary and completely submerged in the developer material". The claim was rejected over a reference which taught all the structural limitations of the claim for the intended use of mixing flowing developer. However, the mixer was only partially submerged in the developer material. The Board held that the amount of submersion is immaterial to the structure of the mixer and thus the claim was properly rejected.).

2115 [R-2] Material or Article Worked Upon by Apparatus

MATERIAL OR ARTICLE WORKED UPON DOES NOT LIMIT APPARATUS CLAIMS

"Expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim." Ex parte Thibault, 164 USPQ 666, 667 (Bd. App. 1969). Furthermore, **"[i]nclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims."** *In re Young*, 75 F.2d 996, 25 USPQ 69 (CCPA 1935) (as restated in *In re Otto*, 312 F.2d 937, 136 USPQ 458, 459 (CCPA 1963)).

In *In re Young*, a claim to a machine for making concrete beams included a limitation to the concrete reinforced members made by the machine as well as the structural elements of the machine itself. ***The court held that the inclusion of the article formed within the body of the claim did not, without more, make the claim patentable.***

10. The claimed device is an article. The article does not include the first or second substrates. The article is comprised of an applicator that is pre-moistened with a chemical reactant and a pouch having the applicator. Applicant intends to use the article "for chemical reactant delivery to between a first metal substrate and a second metal substrate as part of a polymerization reaction". Applicant intends to place said chemical reactant on a first or second substrate and then bring the substrates together to initiate polymerization. **But the device claimed by Applicant is simply the pre-moistened applicator and a package having a pouch.** Applicant's desire to use the claimed device to apply adhesive to two substrates does not require that the prior art provide the substrates.

The Examiner especially directs Applicant to *In re Young*, highlighted and italicized above. Applicant's claim is drawn to a device (the applicator with reactant and pouch) and also includes an additional limitation directed to the **substrates worked on by the device**. The inclusion of the material (substrates) being worked on by the structure being claimed – and being argued by Applicant - does not impart patentability to the claims. Therefore, the Examiner has not given the limitations directed to the substrates any patentable weight.

11. Applicant has also argued that Mainwaring does not teach “an anaerobic polymerization chemical”. The Examiner respectfully disagrees and notes that Mainwaring recites the use of cyanoacrylate monomers in column 20, lines 55-67 and organometallic initiators (column 24, lines 1-22) - both of which may be used in anaerobic polymerizations.

12. Applicant has also argued that one of ordinary skill in the art would not be motivated to combine the Mainwaring and Boeder references. The Examiner disagrees. The passage Applicant cited from Mainwaring (column 1, lines 37-47) is directed to the speed that curing occurs *once the reaction has started*. Mainwaring also notes that the adhesive may be used on various materials (glass, metal, etc.) and also biological tissues. The passage from Boeder (column 7, lines 51-68) is directed to the difficulty in *achieving cure – if at all - when non-metal substrates are being bonded*. Boeder specifically states that “it is known that anaerobically curing compositions, including those of the present invention when the compositions of the present invention are to be employed in bonding operations involving relatively inactive metals or nonmetal substrates or combinations thereof, it is often desirable or perhaps even necessary to employ an appropriate activator which is pre-applied to at least one of the surfaces to be bonded.

The Examiner submits this is not a teaching away, but instead is motivation to combine the references. Mainwaring teaches an applicator for placing polymerization compounds on a non-metal substrate. The polymerization monomer is a cyanoacrylate.

Boeder also teaches a curing composition having a cyanoacrylate as the polymerization monomer (column 3, lines 22-50). Boeder teaches that these reactions may not occur on non-metal substrates, but that their initiator may be employed to ensure reaction takes place. It would have been obvious to one of ordinary skill in the art, then, to use Boeder's initiator with the application system of Mainwaring. One would use Boeder's initiator to ensure or improve activation of the polymerization when the compounds are applied to non-metal substrates.

Conclusion

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DWAYNE K. HANDY whose telephone number is (571)272-1259. The examiner can normally be reached on M-F 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on (571)-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dwayne K Handy/
Examiner, Art Unit 1797
August 2, 2008

/Jill Warden/
Supervisory Patent Examiner, Art Unit 1797